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FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			EXAMINER THEIN, MARIA TERESA T	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/898,497
Filing Date: July 05, 2001
Appellant(s): TANAKA ET AL.

MAILED

DEC 13 2007

GROUP 3600

Daniel R. Brownstone
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed September 21, 2007 appealing from the Office action mailed August 25, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

2002/0077130	OWENSBY	6-2002
6,411,891	JONES	6-2002

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4, 6-13, 15, 17-24, 26, 28-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby (US 2002/0077130 A1).

As per claim 1, Owensby discloses a method for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising the steps of: determining whether a location of the MU is inside or outside a predetermined subsidized zone (see paragraph 60); responsive to a determination that the location of the MU is inside the subsidized zone, adjusting the billing rate for the telecommunications connection to a first predetermined billing rate

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(see page 11, paragraph 72); and responsive to a determination that the MU is outside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connection to a second predetermined billing rate (it is inherent that a non-subsidized rate will apply when the user is not in a subsidized zone, see page 12, paragraph 79). Owensby does not explicitly disclose that it is responsive solely to a determination that the MU is inside or outside the predetermined subsidized zone but it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the method of Owensby as claimed since dealing with a mobile unit and it would be appropriate to determine the billing rate based solely to a determination of the MU on the inside or outside the subsidized zone. That would allow the system to target their ads based on the location of the subscriber's cell phone.

As per claim 2, Owensby discloses a method wherein the first predetermined billing rate is less than the second predetermined billing rate (it is inherent that the subsidized rate will be less than the non-subsidized rate).

As per claim 4, Owensby discloses a method wherein the location is determined by a Global Positioning System (GPS) (see page 7, paragraph 45).

As per claim 6, Owensby discloses a method wherein information corresponding to the predetermined subsidized zone is stored in a database (see page 8, paragraph 52).

As per claim 7, Owensby discloses a method wherein the predetermined subsidized zone information comprises a time period (see page 10, paragraph 64; wherein the Ad Selection is determined by among other things, "date and time"), and

wherein the billing rate is reduced when the telecommunications connection occurred at least in part during the time period.

As per claim 8, Owensby discloses a method wherein the predetermined subsidized zone is defined by a geographical point and a radius (it is inherent that cellular phone systems include zones that are defined by a radius, see page 7, paragraph 45).

As per claim 9, Owensby discloses a method wherein the predetermined subsidized zone is associated with a proximity to a commercial establishment (see for example, page 3, paragraph 15, "restaurant in the area") and the commercial establishment pays the first predetermined billing rate (it is inherent that the commercial establishment pays the subsidy).

As per claim 10, Owensby discloses a method wherein the predetermined subsidized zone is one of a plurality of predetermined subsidized zones, each associated with a proximity to a different commercial establishment (it is inherent that the system is used over in a plurality of locations with a plurality of commercial establishments, see page 10, paragraph 60); and

As per claim 11, Owensby discloses a method wherein the billing rate is reduced by a first amount when the location of the MU is within a first predetermined subsidized zone, and the billing rate is reduced by a second amount when the location of the MU is within a second predetermined subsidized zone (see page 11, paragraph 72, wherein it is noted that the subsidy is flexible and changes dependent on numerous factors).

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As per claim 12, Owensby discloses a system for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising: a processor (operator billing system 32, see page 10, paragraph 60); memory for storing computer readable instructions that, when executed by the process, cause the system to perform billing operations. In regards to independent **claim 23**, Owensby discloses a computer program product for determining a billing rate of a mobile telecommunications connection associated with a mobile telecommunications unit (MU) comprising a computer-readable medium containing computer program code for performing billing operations. In order to omit redundant explanations of claimed limitations, it is noted that Owensby discloses all the elements cited in claims 12-33 as outlined in detail for similar claims 1-11. Owensby does not explicitly disclose that it is responsive solely to a determination that the MU is inside or outside the predetermined subsidized zone but it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize the method of Owensby as claimed since dealing with a mobile unit and it would be appropriate to determine the billing rate based solely to a determination of the MU on the inside or outside the subsidized zone. That would allow the system to target their ads based on the location of the subscriber's cell phone.

Claims 3, 5, 14, 16, 25, and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Owensby (US 2002/0077130 A1) in view of Jones (US 6,411,891).

As per claims 3 and 5, Owensby discloses all of the limitations as set forth above but fails to explicitly state alternative methods of determining the geographic location of the mobile unit. Jones specifically teaches the use of detecting the geographic location of a mobile telecommunications unit by longitude and latitude (see column 17, lines 8-10) and Universal Transverse Mercator (UTM) numbers (see column 17, lines 8-10).

Since claims 14 & 16 and 25 & 27 are identical to claims 3 & 5, a detailed description of each limitation will not be repeated.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Owensby with the location detection mechanism of longitude/latitude or UTM as taught by Jones, because the use of an accurate geographic location mechanism as taught will improve the efficiency and the successfulness of the advertisements, wherein the system will be able to better pinpoint the proximity of the mobile unit to a commercial establishment.

(10) Response to Argument

On page 4 third paragraph under Argument, Appellants argues that "the Examiner's contention, however, that the steps of claim 1 are an obvious modification of Owensby is incorrect and in fact such a modification of Owensby would alter its principle of operation". On page 6 third paragraph under Argument, Appellant further argues in detail that the obvious modification of Owensby "does not teach the claimed element of responsive solely to a determination that the location of the MU is inside the predetermined subsidized zone, adjusting the billing rate for the telecommunications

connections to a first predetermined billing rate", "thus there is no prima facie support for the rejection". On page 7 first paragraph under Argument, Appellant argues that the "combination that changes the principle of operation of a reference or which renders it unsatisfactory for its intended purpose is improper".

The Examiner does not agree. Owensby does teach "responsive to a determination that the location of the MU is inside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connections to a first predetermined billing rate". Owensby discloses a cell phone subsidy program that determines a cell phone user's geographic location (see at least paragraph 45) and based on the user's location offers the user a reduced cell phone billing rate if the user agrees to listen or view the advertisement (see at least paragraph 32 on page 6). Messages (ads) are chosen from a database of pre-selected commercial information or advertisements and are targeted to the subscriber of the wireless mobile communications service on the basis of Wireless Mobile Location data included with the call signal (paragraph 2). The messages can be targeted to the subscriber of the wireless mobile communications service solely on the basis of the wireless mobile location of the terminal and consequently the geographical location of the subscriber (paragraph 11). An Ad Chooser of the Call management systems server chooses the messages to be provided to the subscriber on the basis of the Wireless Mobile Location Data included with the call signal of the wireless mobile communication (paragraph 18). Owensby further discloses the subsidizing the cost of a wireless mobile communication service before and during a wireless mobile communication that are targeted to the subscriber of the

service on the basis of the wireless mobile location of the subscriber's wireless mobile terminal (paragraph 32). The Wireless Mobile Location Data determines the wireless mobile location of the subscriber within a predetermined cell, or within a predetermined sector of a given cell of the operator's network (paragraph 45). Owensby further discloses a subscriber billing program which interfaces with the data management program to determine the subscriber billing subsidy to be applied to the subscriber account (paragraph 60). The operator of the service can offer subsidized wireless mobile communication to its subscribers while at the same time providing advertising. Owensby discloses a candidate discriminator module which determines what subscribers are to be provided with targeted advertisements (paragraph 61). If the candidate discriminator module determines that the subscriber identification code identifies a subsidized subscriber, the candidate discriminator module passes the switch data to the information processing system where an Ad selection code generator generates the Ad selection code (paragraph 61). If the subscriber elects to not receive or to cancel the advertisement within a predetermined elapsed time, an indication is made in the Ad insert records of the subscriber. As a result, the subscriber will be billed normal non-subsidized rate for the call and may be charged a small premium by the operator of the service. (Paragraph 62) Moreover, Owensby discloses a multi-step process of the algorithm of the call routine generator (paragraph 65). First, all advertisement that are not active are eliminated. Second, a subscriber identification code of the ad selection code is compared to the advertisements available from the ad content data to eliminate further consideration those advertisements identified as being

recently inserted into calls made by the same subscriber. Third, the wireless mobile location data of the ad selection code is compared to the target locations of the ad target data to eliminate from further consideration those advertisements which have a location requirement that is not satisfied by the ad selection code. Fourth, the date and time code of the ad selection code is compared to the target dates and times of the ad target data to eliminate from further consideration advertisements which is not satisfied by the ad selection code. (Paragraph 66) Fifth, the subsidy level of the subscriber is determined. (Paragraph 67) The multi-step process of the algorithm continues until no advertisements is acceptable for insertion into the call on the basis of either the original or reduced criteria established by the sponsors of the advertisements. In this instance, the call routine generator will insert a pre-recorded announcements to he subscriber stating that no sponsored advertisements are available to subsidize the call.

(Paragraph 67 and paragraph 71) For subscribers who agree to receive the advertisements, the call routine generator creates a call routine algorithm providing for a few minutes of subsidy, after which the call is no longer subsidized. For subscribers who agree to accept interruptions during a call, the call routine generator creates a call routine algorithm for managing the call which includes an appropriate number of advertisements, such that the entire call may be subsidized. (Paragraph 72)

Such a cell phone subsidy program that determines a cell phone user's geographic location and based on the user's location offers the user a reduced cell phone billing rate if the user agrees to listen or view the advertisement; messages targeted to the subscriber of the wireless mobile communications service solely on the

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basis of the wireless mobile location of the terminal and consequently the geographical location of the subscriber; the subsidizing the cost of a wireless mobile communication service before and during a wireless mobile communication that are targeted to the subscriber of the service on the basis of the wireless mobile location of the subscriber's wireless mobile terminal; a subscriber billing program which interfaces with the data management program to determine the subscriber billing subsidy to be applied to the subscriber account; a candidate discriminator module which determines what subscribers are to be provided with targeted advertisements and if the candidate discriminator module determines that the subscriber identification code identifies a subsidized subscriber; if the subscriber elects to not receive or to cancel the advertisement within a predetermined elapsed time, an indication is made in the Ad insert records of the subscriber and as a result, the subscriber will be billed normal non-subsidized rate for the call and may be charged a small premium by the operator of the service; and the multi-step process of the algorithm of the call routine generator which includes no advertisements is acceptable for insertion into the call on the basis of either the original or reduced criteria established by the sponsors of the advertisements, subscribers who agree to receive the advertisements, the call routine generator creates a call routine algorithm providing for a few minutes of subsidy, after which the call is no longer subsidized, and subscribers who agree to accept interruptions during a call, such that the entire call may be subsidized are considered "responsive to a determination that the location of the MU is inside the predetermined subsidized zone, adjusting the billing rate for the telecommunications connections to a first predetermined billing rate".

The Examiner then asserts "Owensby does not explicitly disclose that it is response solely to a determination that the MU is inside or outside the predetermined subsidized zone" that "it would have been obvious to one of ordinary skill in the art at the time of invention was made to utilize the method of Owensby as claimed since dealing with a mobile unit, it would be appropriate to determine the billing rate solely to a determination of the MU on the inside or outside the subsidized zone. That would allow the system to target their ads based on the location of the subscriber's cell phone." Furthermore, it would have been obvious to one of ordinary skill in the art at the time of invention was made to modify the method of Owensby to include the responsive solely to a determination that the location of the MU is inside or outside the subsidized zone, so as for a means of reducing subscribers service charges while maintaining operator profit margins (Owensby, paragraph 5), by targeting subscribers on the basis of the real-time, physical location of the wireless mobile terminal (mobile unit) at the time of the wireless mobile communication of the terminal (Owensby, paragraph 7). Furthermore, it provides the subscriber messages which is targeted to the subscriber based on the geographical location of the wireless mobile terminal, thus informing the subscriber of his or her geographical location which can be utilized to subsidize the wireless mobile communications of the subscriber (Owensby, paragraph 9).

On page 8 first paragraph, Appellant argues that "the combination of Jones and Owensby does not teach the claimed invention. As discussed above, Owensby fails to disclose adjusting a billing rate responsive solely to a determination that the location of

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the MU is inside the subsidized zone....That combination, ..., does not cure the defects described above with respect to Owensby”.

The Examiner does not agree. The combination of Jones and Owensby does teach the claimed invention. Specifically, the modification of Owensby does teach “the adjusting a billing rate responsive solely to a determination that the location of the MU is inside the subsidized zone”, as discussed above. Jones was cited for teaching the use of detecting the geographic location of a mobile telecommunications unit by longitude and latitude and for the Universal Transverse Mercator numbers.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner’s answer.

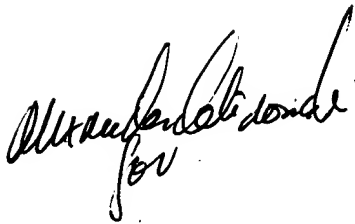

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Marissa Thein

Conferees:

Vincent Millin
Appeal Specialist

Handwritten signature of Vincent Millin in cursive script.Handwritten signature of Michael Cuff in cursive script.
MICHAEL CUFF
PRIMARY EXAMINER

Ryan Zeender
SPE
Art Unit 3627

Handwritten signature of Ryan Zeender in cursive script, with the date 12/10/07 written below it.